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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/876,688      | 06/07/2001  | Terry K. Harper      | 10872-1010          | 8203             |

7590 09/23/2003

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8x

**Office Action Summary**

Application No.

09/876,688

Applicant(s)

HARPER, TERRY K.

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is the fourth Office Action for serial number 09/876,688, Removable Wire Caddy for Electrician's Ladder, filed on June 7, 2001. Claims 1-5, 7-9, and 11-22 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/15/03 has been entered.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: on line 13, "rails" should be --rail--. Appropriate correction is required.

Claims 7 and 8 are objected to because of the following informalities: on line 3, delete "step" before "ladder". Appropriate correction is required.

Claim 15 is objected to because of the following informalities: on line 18, insert -- and wherein-- before "a spool" and on line 19, insert --adapted to be-- before "paid out". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "said step" in line 9 and "said pair of parallel spacer arms" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the front of the side rails " in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 7, 8, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,705,283 to Kleisath in view of U.S. Patent 1,341,484 to Starratt. With regards to claims 1-5, 7, 8 (as best understood) and 15-22, Kleisath discloses a support attachment comprising: a handle/spacer (8) comprising an arm (at 8) and a side rail engaging means comprising a rectilinear support bar (11) having opposed ends and rigidly connected to the arm (at 8); a U-shaped frame (4) extending forwardly from, parallel to, and rigidly connected to the support bar (11) for rotatably supporting wire spools (29), the frame comprising parallel spaced side legs (6) having

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openings and extending from end portions of a base leg (7) that is joined to the support bar (at 8), and a rectilinear, horizontally-oriented spool support rod (28) having opposed ends releasably mounted within the openings of the U-shaped frame side legs (6); wherein the support bar (at 8), side rail engaging means (11), and U-shaped frame (4) are of one-piece construction, occupy a common plane and define oppositely facing C-shaped recesses. Kleisath does not disclose the handle/spacer including two parallel, spaced apart arms (at 8). Starratt discloses a support attachment (Fig. 1) comprising a handle including a rectilinear support bar (2) rigidly connected to a pair of parallel, spaced apart arms (1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the handle to include an additional arm parallel to and spaced from the arm (at 8) as taught by Starratt because one would have been motivated to provide a stronger interconnection between the rectilinear handle bar (7) and U-shaped frame (4).

Claims 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,533,091 to Knight et al. (Knight) in view of Kleisath in view of Starratt as applied to claims 1-5, 7, 8, and 15-22 above and further in view of U.S. Patent 4,869,344 to Peterson. With regards to claims 9 and 11-14, Knight teaches positioning a wire caddy (13, 14 generally) on the side rails of a ladder (11) and horizontally orienting a spool support rod (13) having wire spools thereon. Knight does not teach suspending the spool support rod between distal ends of parallel legs of a U-shaped frame or configuring the wire caddy to include a support bar, pair of spacer bars, and base leg to form oppositely facing C-shaped recesses so as to register about the side

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rails of the ladder (11), wherein the base leg rests on a step located between the side rails. Kleisath in view of Starratt discloses the support attachment as applied above and inherently teaches method steps recited in claims 9, 11, 12 and 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the support attachment of Kleisath in view of Starratt for the wire caddy (13, 14 generally) because one would have been motivated to provide a portable wire caddy that is quickly and easily installed as inherently taught by Kleisath in view of Starratt. Additionally, Knight in view of Kleisath in view of Starratt does not teach securing the spool support rod (28) to the ends of the parallel legs (6) by positioning locking pins in opposing ends of the spool support rod (28). Peterson teaches securing a spool support rod (46) to parallel legs (42, 44) by positioning locking pins (52, 54) in opposing ends of the support rod (46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position locking pins in opposing ends of the spool support rod (28) because one would have been motivated to fix the ends of the spool support rod against passage through the parallel arms (6) as taught by Peterson (col. 3, lines 29-33).

### ***Response to Arguments***

Applicant's arguments filed 8/15/03 have been fully considered but they are not persuasive.

In response to applicant's argument that "neither Starratt nor Kleisath perform the same function as described by applicant" and that "there is no disclosure or suggestion

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Kleisath could mount his spool carrier to a ladder”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding applicant's argument that “it does not seem logical that such a spool could be safely mounted to a ladder”, examiner respectfully disagrees. While Kleisath does teach the holder supporting heavy spools as recited by applicant, Kleisath additionally teaches supporting smaller spools of wire (29) and is therefor fully capable of supporting wire spools if mounted on a ladder. Additionally, examiner does not agree with applicant's assertion that the distance between the handlebar 11 and cross bar 7 is so great that the holder would sag down toward the floor.

Regarding applicant's argument that Starratt does not improve the function of Kleisath, examiner respectfully disagrees. As recited in the rejection above, the combination of the teachings of Starratt with Kleisath provides a holder (as taught by Kleisath) having a handle that is stronger and less likely to break under heavy stresses from the load carried thereon. Additionally, regarding applicant's argument that “attaching the Starratt mulch layer to a ladder would be strictly in hind sight”, applicant is reminded that Starratt is a secondary reference and has only been relied upon to teach the addition of a spacer bar parallel to the bar (8).



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In response to applicant's argument that the device of Kleisath would "likely not suspend the reels above the floor, but allow them to engage the floor", examiner respectfully disagrees. As stated above, the device of Kleisath is adapted to be supported by a ladder in the manner described by applicant and the configuration of the holder does not support applicant's assertion that the holder would be tilted downwardly such that the reels would engage the floor.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of references is supported by the teachings and motivation found in the references (as

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cited above) in addition to the knowledge generally available to one of ordinary skill in the art (as cited above).

### CONCLUSION

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 872-9325.



*Naschica S. Morrison*

Patent Examiner

Art Unit 3632

9/17/03



Korfe Chan

Primary Examiner

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